

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

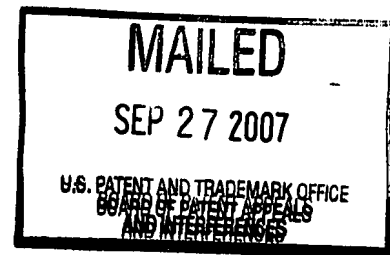
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Ex parte: MARK R. JOHANSEN

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Application No. 09/606,702

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on September 15, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**APPEAL BRIEF**

**Summary Of Claimed Subject Matter**

Appellant filed a Substitute Appeal Brief dated May 9, 2006, in response to the Final Rejection mailed March 22, 2004. The Substitute Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

\* \* \*

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief . The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

The Examiner is advised that the Substitute Appeal Brief is not properly identified in the PALM system, it is labeled as a Miscellaneous Incoming Coming Letter.

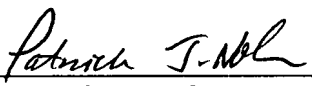
**CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the examiner to:

- 1) hold the Substitute Appeal Brief filed May 9, 2006, defective;
- 3) notify the Appellant to submit a “paper” which corrects the Appeal Brief, Summary of Claimed Subject Matter;
- 4) acknowledgement and consideration of any “paper” that may be submitted by Appellant in response to the Notice of Non-Compliance to correct the Substitute Appeal Brief as required by 37 CFR 41.37(c)(1)(iii),(v); and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

  
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